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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/763,294

01/22/2004

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07/25/2008

EXAMINER

HALL, DEANNA K

ART UNIT

PAPER NUMBER

3767

MAIL DATE

DELIVERY MODE

07/25/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |  |  |
|------------------------------|--------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/763,294 | <b>Applicant(s)</b><br>SHKARUBO ET AL. |  |
|                              | <b>Examiner</b><br>DEANNA K. HALL    | <b>Art Unit</b><br>3767                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Acknowledgments*

1. This office action is in response to the reply filed on April 15, 2008 and the affidavit filed on January 8, 2008 and January 25, 2008.
2. In the reply, the applicant did not amend any claims. Claims 1-6 are pending in the application.
3. The examiner acknowledges the preliminary amendment filed March 15, 2004 which makes amendments to the specification.

### *Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Shkarubo RU 2160058.** Shkarubo discloses.

A device for placing medical instruments, comprising: a body with an instrumental guide, a means for preliminarily fixation of a medical instrument, a trigger with a depth scale applied onto the body, and a means for delivering a medical instrument consisting of telescopic tubes arranged inside the body, of which one is

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immovably coupled with the body and the second one is movable, spring-loaded, mounted with its end portion in a body end face guide and has a detent for retaining said medical instrument and an arresting device provided in a body slot movable in a longitudinal direction and cooperate with the end face of the slot; the trigger being disposed on the body with a faculty of travel, fixation and interaction with the detent to set a depth of mounting of said medical instruments, see Claim 1, characterized in that the smallest portion of said movable tube within said stationary tube is at least one-half the outer diameter of said movable tube, and the distance between said body end face guide and the end portion oriented thereto of said stationary tube is from 2 to 25 outer diameters of said movable tube, see Fig. 1, and more important, said means for preliminary fixation of a medical instrument and the medical instrument retention detent are adapted to interact with the medical instrument introduced from one and/or the other end of the body see Page 5 column 2 lines 53-60 and Page 6 column 2 lines 6-13.

The trigger is configured as a collar and a double-arm spring-loaded lever hinge jointed with the collar, the latter has an adjusting screw, and one arm of the spring-loaded double-arm lever has a surface for cooperation with the detent, see Claim 2.

The instrumental guide is a hollow needle connected to said body via a connector and a cone being congruent thereto and provided on the first tube, see Claim 3.

The instrumental guide is configured as a Tuohy needle, see Claim 4.

The body is provided with a cap arranged on its end on the side of said instrumental guide, said cap retaining said means for delivering a medical instrument in said body, see Claim 5.

The means for preliminary fixation a medical instrument and said detent for retaining a medical instrument are spring grips of one-sided and/or double-sided action, see Claims 7-8.

### ***Response to Arguments***

6. Applicant's arguments and the affidavit have been fully considered but they are not persuasive. The affidavit does not overcome the rejection because, even as stated in applicant's own affidavit, the prior art is a "prototype" of the currently claimed invention. The "prototype" of the device of RU 2160058 was being improved for better stability. "When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under §103." *KSR International Co., v. Teleflex Inc. et al.* 127 U.S. 1727, 1742(2007). The fact that, as applicant notes in the remarks on page 2, the reason for the insufficient stability of the device of RU 2160058 is impact interaction of the end of the body cut and the movable stop in the cut suggests that there was a design need to solve a problem (stability) and changing the ratios of coaxial tubes would have been obvious to try.

***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DEANNA K. HALL whose telephone number is (571)272-2819. The examiner can normally be reached on M-F 9:00am-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Simons can be reached on 571-272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Deanna K. Hall/

Examiner, Art Unit 3767

7/9/08

/Kevin C. Sirmons/

Supervisory Patent Examiner, Art Unit 3767